REMARKS/ARGUMENTS

A. INTRODUCTION

In the office action dated May 20, 2004 (hereafter "Office Action"):

claims 1-7, 9, 11-15, 17 and 19-22 were rejected under 35 USC § 102(b) as being anticipated by U.S. patent no. 4,862,451 to Closs et al. (hereinafter "Closs");

claims 8 and 16 were rejected under 35 USC § 103(a) as being unpatentable over Closs in view of U.S. patent no. 5,563,878 Blakeley et al. (hereinafter "Blakeley"); and

claims 10 and 18 were objected to as being dependent upon a rejected base claim, but are allowable if rewritten in independent form including all of the limitations of the base claim.

B. REJECTION UNDER 35 U.S.C. § 102(b): claims 1-7, 9, 11-15, 17 and 19-22

Applicant submits that claims 1-7, 9, 11-15, 17 and 19-22 are patently distinguishable with respect to Closs because Closs fails to teach or suggest one or more features claimed in the several embodiments of the present invention. In particular, the prior art fails to suggest creating or constructing an edit program for a packet using or in response to a disposition decision for the packet.

Representative claim 1 recites: An edit module comprising:

an edit program construction engine,

wherein the ***edit program construction engine*** creates an ***edit program*** for a packet in ***response to a disposition decision*** for the packet, and wherein the edit program is applied to modify the packet.

An edit program is preferably a computer program comprising a number of instructions that may be stored in the switching controller memory and subsequently executed by an engine to modify the inbound packet and produce an outbound packet (page 3, lines 12-15). Using edit programs for incoming packets, a single switching element may subject

PAGE 8/12 * RCVD AT 8/18/2004 5:56:59 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:1 818 225 1569 * DURATION (mm-ss):04-10

Best Available Copy

different packets to different packet editing routines, thereby enabling "differential packet editing." For example, packets having different routing, policing and/or accounting characteristics may be subjected to different editing processes. Moreover, an edit program for a packet in some embodiments may even be used to subject each packet to an editing routine that is individually tailored for the packet, thereby enabling "customized packet editing." (see e.g. p.11, lines 6-8; p.12, lines 9-10).

In contrast to the claimed edit program construction engine, Closs discloses "packet editing circuitry 45." The packet editing circuitry 45 appears to be a conventional fixed hardware approach to packet editing that subjects all packets to a "canned" editing process. Applicant is unaware of any suggestion in Closs that the packet editing circuitry 45 generate a program for constructing even a single edit program.

The Examiner is correct in stating that the packet editing circuitry 45 modifies each incoming packet by adding a two-byte local routing address and a two-bit tag to each packet. (Office Action, pp. 2-6). However, these packet modifications are not achieved by executing the instructions of an edit program created for the packet. Instead, Closs discloses that the local routing address is retrieved for each packet by looking-up the packet's system destination address in a stored address conversion table (col. 11, lines 21-24), and the appropriate tag is retrieved for each packet from one of the registers 107A, 107B and 107C (col. 11, lines 25-58). The approach described in Closs is therefore a strictly non-adaptive, hardwired approach to packet editing. Closs does not involve execution, much less construction, of an edit program for a packet as recited in the present claims and is therefore incapable of offering, among other advantages, differential or customized packet editing.

Notably, nowhere in Closs is there even a any mention or suggestion of either an edit program or edit instructions. This is telling of the significant difference between the inflexible approach to packet editing described therein and the Applicants' adaptive approach.

PAGE 9/12 * RCVD AT 8/18/2004 5:56:59 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:1 818 225 1569 * DURATION (mm-ss):04-10

Best Available Copy

In addition to the edit program construction engine and edit program, Closs also fails to disclose that the edit program is created for the packet in *response to a disposition decision* for the packet. By creating an edit program based at least in part on a disposition decision for a packet—as opposed to, for example, creating an edit program based solely on an inbound destination address of the packet—it is possible to tailor edit programs for packets to comport with logical groups into which packets have been identified. For example, a common editing routine can be applied to all packets whose disposition decisions indicate membership in the same logical group—e.g., packets having the same routing, policing and/or accounting characteristics—while different editing routines can be applied to packets whose disposition decisions indicate membership in different logical groups—e.g., packets having different routing, policing and/or accounting characteristics.

In contrast to the present invention, Closs merely uses an inbound packet's destination address to edit a packet. However, an inbound destination address is not a disposition decision. As stated in the presented specification, a disposition decision may include information derived from an inbound packet header, such as outbound routing, policing and/or accounting data, but not information extracted from an inbound packet header. See, e.g., p.10, lines 18-23; and p.11, line 28, to p.12, line 7.

Claim 1 is therefore patently distinguishable over Closs and the rejection must be withdrawn. Like claim 1, other independent claims recite similar features and are allowable for the same reasons discussed above:

claim 5 ("second engine for executing the edit program to modify the inbound packet"),

claim 13 ("modifying the inbound packet by executing the edit program"),

claim 21 ("second engine for executing the edit program to modify the inbound packet"), and

claim 22 ("means for executing the edit program to modify the inbound packet").

PAGE 10/12 * RCVD AT 8/18/2004 5:56:59 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:1 818 225 1569 * DURATION (mm-ss):04-10

Best Available Copy

C. REJECTION UNDER 35 U.S.C. § 103(a): claims 8 and 16

Claims 8 and 16 are patently distinguishable from Closs and Blakeley, either alone or in combination, because there is no motivation to combine these references and the combination fails to disclose one or more features of the claimed invention. Although Examiner has stated that one of ordinary skill would be motivated to sequentially determine whether to route and if necessary reroute a packet (Office Action, paragraph 4), this statement does not provide a motivation to organize and or integrate the instructions of the edit program so that those instructions are executed serially. That is, neither Closs or Blakeley suggests arranging the instructions associated with constructing and storing steps of the edit program in a serially executable fashion.

Claims 8 and 16 are also dependent on base claims 3 and 13, respectively, and are allowable for the reasons stated in section B above. Therefore, the Applicant respectfully asserts that the rejection of claims 8 and 16 is also improper and should be withdrawn.

D. CLARIFYING AMENDMENTS

By this amendment, Applicant has made purely formal amendments to claim 5, 13, 21 and 22 by replacing the single word "to" with "and" in the first instance, adding the single word "and" in the second instance and adding the single word "in" in the latter two instances. These amendments are unrelated to the prior art and not made for reasons of patentability.

E. CONCLUSION

For all the forgoing reasons, Applicant submits that the present invention is patently distinguishable from Closs or Blakeley either alone or in combination. Accordingly, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Pursuant to 35 U.S.C. 132 and 37 CFR 1.121, Applicant has exercised care to avoid the introduction of new matter. Should there be any fees for this action, your office is authorized to draw from the firm deposit account number 02-3979. Should you have any

PAGE 11/12 * RCVD AT 8/18/2004 5:56:59 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:1 818 225 1569 * DURATION (mm-ss):04-10

Best Available Copy

questions, or identify any problem, I would appreciate a telephone call so that this matter may be resolved promptly.

Respectfully submitted,

Michael Blaine Brooks, PC

By: Andrew S. Naglestad

Andrew S. Naglestad
Reg. No. 47,814
5010 No. Parkway Calabasas
Suite 104
Calabasas, CA 91302
Tel.: (818) 225-2920 ext. 202

PAGE 12/12 * RCVD AT 8/18/2004 5:56:59 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:1 818 225 1569 * DURATION (mm-ss):04-10

Best Available Copy